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Application No. 09/493,517

Atty Docket: CMRC 1012-1

REMARKS

Claims 1-35 are pending in this application. As a result of a first restriction requirement, claims 1-13 were previously withdrawn. In response to the outstanding Office Action, a further restriction requirement, Applicants provisionally elect, with traverse, the species of Group I (i.e., Claims 14-30, characterized as being drawn to a method of extending a definition of a tag used in an electronic document).

Traverse of Restriction Between Claims 14-30 and 31-35

Contrary to the Examiner's argument, it is not enough to support restriction for the Examiner to argue that subcombinations have distinct utility by themselves. The MPEP requires more. The meaning of "distinct" is given by § 802.01:

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

(emphasis in MPEP). Restriction requires more than showing that claims are distinct.

Under MPEP § 803.01,

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 -§ 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) -§ 806.04(i), § 808.01(a), and § 808.02).

Applicants assert that no serious burden would be imposed by examining claims 14-35 in one group. First, the Examiner does not offer any basis for arguing a serious burden. (Boilerplate paragraph 5 does not fit this application, as the Examiner identified two groups, not three, and the Examiner's statement is both conclusory and contradicted by the Examiner's own prior search.) Second, the Examiner previously

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completed a search covering claims 14-35 after a first restriction requirement and rejected the claims. Third, an International Search Report performed by the EPO is attached, which does not assert any lack of unity. The Examiner has two searches covering the relevant subject matter, which refutes any claim that the Examiner later may make of a serious burden. The Examiner already has examined all 22 claims in an office action, without any complaint of serious burden. One restriction requirement in a case is all that Applicants should be asked to accept, especially where only 35 claims (22 claims after the first restriction) are involved. Applicants respectfully suggest that this second restriction requirement be withdrawn.

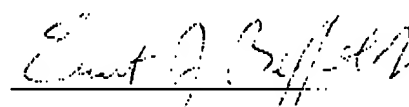
CONCLUSION

Applicants respectfully submit that the claims, as stated herein, are in condition for allowance and solicit acceptance of the claims, in light of these remarks. If the Examiner disagrees and sees amendments that might facilitate allowance of the claims, a call to the undersigned would be appreciated.

If a telephone conference would assist in resolving any issues, the undersigned can normally be reached at (650) 712-0340 Monday through Friday, from 8:30 AM through 5:30 PM, excepting lunch.

Respectfully submitted,

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